

REMARKS/ARGUMENTS

The Examiner has rejected claims 51 - 53 and 77 under 35 U.S.C. 103(a) as being unpatentable over Lorber modified by Mitchell and in further view of Dawson. However, none of the references cited, alone or in combination contain, teach or imply all of the elements of Applicant's invention as claimed.

Applicant's invention, as disclosed by independent claim 51 includes, includes a card body comprising an outer panel and an inner panel, an opening in the inner panel capable of receiving a machine readable storage medium, and indicia on the machine readable storage medium that is thematically related to that of the greeting card.

Lorber teaches two panels glued together on all but one side to form a top-receiving pocket. The inner panel also includes a hole through which to view a record label. Where the pocket is formed in front portion of the greeting card, a fold line may be used to create a second portion on which general greeting card indicia may be inscribed.

Lorber, therefore, does not teach an inner panel with an opening used to receive any items. It is only the adhered combination of the *two* panels of Lorber that are utilized to receive a phonographic record. Specifically, two sheets "are connected together to form the 20 pocket (3.1) as a record receiving sleeve." Lorber, at col. 2, lines 19-20. Therefore, Lorber does not disclose "a first opening formed in said inner panel second face" in any way similar to Applicant's invention. Applicant, Claim 51. The only "opening" that may be found in Lorber's panels is a die-cut viewing hole. In fact, the position and size of the viewing cut-out teaches away from the device of Lorber from holding any items in the cut-out. Specifically, the die-cut is "for viewing what is

received in the record sleeve." Lorber, at col. 2, lines 23-24. Therefore, Lorber specifically teaches away from receiving *anything* in the opening, as only the "record sleeve" is used for receiving items.

Additionally, the device of Lorber is specifically designed to receive phonographic records and no other items. Lorber's device is specially designed to receive and display phonographic records by means of its top-loading record sleeve and die-cut vieweing hole. Phonographic records are well-known to comprise a grooved exterior with a three-inch or so diameter centrally-located label. It is this aspect of phonographic records that the device of Lorber is intended to take advantage of.

In addition, Lorber clearly shows that only phonographic records and no other items are received. The description of the related prior art is quite illustrative.

The present invention provides a means to recycle inactive record catalogues beyond the former conventions by reissuing them in a unique and novel reissue-device. The greeting card having a record sleeve for receiving an audio disc permits a functionally new recycling purpose that distinguishes it from previously utilized ordinary standard record sleeves and greeting cards.

Lorber, col. 1, lines 30-37.

Further, Lorber also mentions Compact Discs (CD) to distinguish them from the receivable items for the present invention. It may be physically possible to drop a CD into the device of Lorber, but to do so would make no sense, as an arbitrary portion of the CD would be displayed. In any event, it was for the recycling of the endangered species of 33 1/3 RPM and 45 RPM phonographic records that Lorber's invention was created. Phonographic records were not designed with any type of greeting card indicia, and generally no theme at all, and therefore it can not be argued that the indicia on the record label is thematically related to that of the greeting card. Taken out of context the quote:

“It is the object of this invention to provide a greeting card when combined with a record sleeve can receive a prerecorded audio disc reflecting a portion of the greeting card indicia.” taken from Lorber could be understood to mean that the record somehow “reflects” a portion of the greeting card indicia. However, an “in context” examination shows why this reading is false. The “record sleeve” is the object that reflects the greeting card indicia. This becomes clear when one considers the fact that the records are original phonographic records bearing labels that would in no way reflect anything, other than their original printing, i.e the record company, artist name, song titles and the like.

It is also important to note that Applicant’s invention comprises a machine readable storage medium. As known in the art, this would not include phonographic records. Even though a phonographic record is technically played on a machine, a record player does not “read” a record in any sense of the word, and certainly not as that term is known in the art. Therefore, this element of Applicant’s invention is also missing and not taught or implied in any manner from Lorber. As such, Lorber can not be relied upon as a basis for any type of rejection, and clearly not a rejection under 35 U.S.C. 103(a).

The Examiner has added the disclosure of Mitchell to that of Lorber as further basis for the rejections. Mitchell has been added to serve as a disclosure illustrating that printing the topic of a video presentation on the video presentation cover is known in the art. Applicant first takes issue with the assertion that there exists any motivation to combine the reference of Lorber with that of Mitchell. Lorber relates to greeting cards with record sleeves and Mitchell to information systems. Mitchell discloses a type of encyclopedic indexing system that may be printed on the jacket holding an audio visual presentation of the encyclopedic material. The information printed on the jacket would

clearly be related to the material on the disc because it includes merely “printed reproductions of part of all of the comprehensive text article” located on the disc. Mitchell, col. 3, lines 17-18. Motivation to identify the disc should it be separated from the card body is not found in any of the prior art references. As a result there is no motivation to combine the greeting card record sleeve of Lorber with the audio-visual encyclopedia system of Mitchell.

Further, even if the combination of the references was properly motivated, the elements of Mitchell do nothing to alleviate the shortcomings of Lorber. Namely, Mitchell, like Lorber, does not disclose the opening of Applicant’s invention, nor does Mitchell disclose a portion of the machine readable storage medium being retained between the inner and outer panels.

The Examiner then attempts to add Dawson to Lorber and Mitchell to account for the fact that neither Lorber or Mitchell discloses that an opening is used to receive the machine readable storage medium. Although Dawson discloses slots for receiving gift articles, Dawson requires the use of *a pair of slots* to hold articles. Applicant’s invention discloses “a first opening” in claim 51. Additionally, the CD gift of Dawson would not be related in any manner to the them of the device overall. Dawson teaches away from such a relationship as there exists an aural message contained with the card itself, played upon opening or removal of the gift item. Therefore, Dawson’s openings vary greatly from the first opening disclosed by Applicant and can not be relied upon as part of a rejection under 35 U.S.C. 103(a).

In conclusion, Mitchell and Dawson both include elements that have some commonality with Applicant’s invention. However, neither of these references include

elements that are applicable for anticipation purposes. Further, Lorber, the primary reference, includes numerous substantial differences that are not in any way alleviated by the addition of other references. As a result, the combination of Lorber, Mitchell and Dawson can not serve as a combination of references rendering Applicant's device obvious.

The Examiner has also rejected the remaining claims as being obvious by relying on the addition of the patents granted to Bradley and Hodes. The remaining references fail to render Applicant's invention obvious for the same reasons as noted above; namely, that the addition of references with narrowly applicable elements do nothing to render Applicant's invention obvious when the primary references relied upon fail in their own right. Therefore, the specific addition of Bradley or Hodes does nothing to render Applicant's invention obvious under 35 U.S.C. 103(a).

In light of the arguments and remarks presented, no amendments to the claims are necessary at the present time.

Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Patrick D. Archibald, Applicant's Attorney at (781) 270-0604 so that such issues may be resolved as expeditiously as possible.

For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Reconsideration and further examination is respectfully requested.

Respectfully Submitted,

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